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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/565,430	03/06/2008	Naomi Okamoto	501/44294/104-PCT-US	7635
279 7590 03/31/2010 TREXLER, BUSHNELL, GIANGIORGI, BLACKSTONE & MARR, LTD. 105 WEST ADAMS STREET SUITE 3600 CHICAGO, IL 60603			EXAMINER CHIN, HUI H	
			ART UNIT 1796	PAPER NUMBER
			NOTIFICATION DATE 03/31/2010	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ptodocket@trexlaw.com

Office Action Summary	Application No. 10/565,430	Applicant(s) OKAMOTO ET AL.	
	Examiner HUI CHIN	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>1/18/2006, 4/4/2006, 3/7/2008, 11/24/2009</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in JP 2005-007557 on 1/14/2005. It is noted, however, that applicant has not filed a certified copy of the Japanese application as required by 35 U.S.C. 119(b).

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

3. Claims 1 and 3 are rejected under 35 U.S.C. 102(a) as being anticipated by Okamoto et al. (JP 2005008817).

Okamoto et al. disclose a polybutadiene composition comprises (A) 10-70 pts.wt. of polybutadiene that includes (a) 1-9 wt. % of insoluble fraction in boiling n-hexane that melts at $\geq 180^{\circ}\text{C}$ and (b) 99-91 wt.% of boiled n-hexane-soluble fraction that has Mooney viscosity (ML) of 35-50 and (B) 90-30 pts.wt. of diene rubber other than (A) and includes (C) 20-80 pts.wt. of rubber-reinforcing agent based on 100 pts.wt. of the rubber components of (A)+(B) wherein a crosslinking agent can be used (claim 1, [0033]).

The limitations of claim 3 can be found in Okamoto et al. at claim 3, where it discloses the cis content of 95% or higher and Mooney viscosity of 35-50.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2 is rejected under 35 U.S.C. 103(a) as obvious over Okamoto et al. (JP 2005008817) in view of Fujisawa et al. (US 2003/0125450).

The disclosure of Okamoto et al. is adequately set forth in paragraph 3 and is incorporated herein by reference.

However, Okamoto et al. are silent on the use of specific polybutadiene.

Fujisawa et al. disclose a rubber composition for golf ball comprising a base rubber, a co-crosslinking agent, an organic peroxide and an inorganic filler, wherein the base rubber comprises a polybutadiene (a) containing a cis-1,4 bond of not less than 80%, having a Mooney viscosity of not less than 30 to less than 50 ML 1+4 (100°C) and a ratio (Mw/Mn) of weight average molecular weight (Mw) to number average molecular weight (Mn) of 3.0 to 6.0, wherein the base rubber is a polybutadiene mixture consisting of the polybutadiene (a) a polybutadiene (c) having a ratio (Mw/Mn) of 3.6 to 8.0 to provide rubber composition for obtaining golf ball having excellent rebound

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characteristics and excellent durability, and showing good workability when producing (claims 1 and 3, [0001]). The polybutadiene has similar molecular weight distribution, thus it possesses the claimed reduction viscosity. In light of such benefit, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the composition with this polybutadiene with the expected success.

6. Claims 4 is rejected under 35 U.S.C. 103(a) as obvious over Okamoto et al. (JP 2005008817) in view of Fujisawa et al. (US 2003/0125450).

The disclosure of Okamoto et al. is adequately set forth in paragraph 3 and is incorporated herein by reference.

However, Okamoto et al. are silent on the use of specific diene-based rubber.

Fujisawa et al. disclose a rubber composition for golf ball comprising a base rubber, a co-crosslinking agent, an organic peroxide and an inorganic filler, wherein the base rubber comprises a polybutadiene (a) containing a cis-1,4 bond of not less than 80%, having a Mooney viscosity of not less than 30 to less than 50 ML 1+4 (100°C) and a ratio (Mw/Mn) of weight average molecular weight (Mw) to number average molecular weight (Mn) of 3.0 to 6.0, wherein the base rubber is a polybutadiene mixture consisting of the polybutadiene (a) a polybutadiene (c) having a ratio (Mw/Mn) of 3.6 to 8.0 to provide rubber composition for obtaining golf ball having excellent rebound characteristics and excellent durability, and showing good workability when producing (claims 1 and 3, [0001]). In light of such benefit, it would have been obvious to one of

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ordinary skill in the art at the time the invention was made to make the composition with this polybutadiene with the expected success.

7. Claims 5 is rejected under 35 U.S.C. 103(a) as obvious over Okamoto et al. (JP 2005008817) in view of Fujisawa et al. (US 2003/0125450).

The disclosure of Okamoto et al. is adequately set forth in paragraph 3 and is incorporated herein by reference.

However, Okamoto et al. are silent on the use for golf ball.

Fujisawa et al. disclose a rubber composition for golf ball comprising a base rubber, a co-crosslinking agent, an organic peroxide and an inorganic filler, wherein the base rubber comprises a polybutadiene (a) containing a cis-1,4 bond of not less than 80%, having a Mooney viscosity of not less than 30 to less than 50 ML 1+4 (100°C) and a ratio (Mw/Mn) of weight average molecular weight (Mw) to number average molecular weight (Mn) of 3.0 to 6.0, wherein the base rubber is a polybutadiene mixture consisting of the polybutadiene (a) a polybutadiene (c) having a ratio (Mw/Mn) of 3.6 to 8.0 to provide rubber composition for obtaining golf ball having excellent rebound characteristics and excellent durability, and showing good workability when producing (claims 1 and 3, [0001]). In light of such benefit, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the composition for golf ball with the expected success.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUI CHIN whose telephone number is (571)270-7350. The examiner can normally be reached on Monday to Friday; 8:00am - 5:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on 571-272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ling-Siu Choi/
Primary Examiner, Art Unit 1796

/HC/